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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/524,297 | 08/23/2005 | Roger John Brooks | 818,103 | 6369 |
| 24106 7590 01/04/2007 EGBERT LAW OFFICES 412 MAIN STREET, 7TH FLOOR HOUSTON, TX 77002 | | | EXAMINER CHIU, RALEIGH W | |
| | | | ART UNIT 3711 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/04/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/524,297

Applicant(s)

BROOKS, ROGER JOHN

Examiner

Raleigh Chiu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>05/27/2005</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ball joint (claim 6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The pivot pin of Figure 11 is not considered to be a ball joint.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the word "means" is preceded by the word(s) "ball joint" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph.

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With further regard to claim 6, the use of "with similar degrees of freedom" is unclear with no point of comparison.

Claim Rejections - 35 USC §§ 102 and 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 5, 15, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,656,056 (Leonard).

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Regarding claims 1, 2 and 5, Figure 1 of Leonard shows the recited elongate member 22 with a mounting clamp 20. the distal end of member 22 corresponds to the recited contact means.

Regarding claim 15, Figure 1 further shows a putter 12.

Regarding claim 16, Leonard describes the recited steps at column 5, lines 58 *et seq.* such that the user's forearm is engaged with the elongate member 22 for a proper stroke.

7. Claims 1-3, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 6,004,221 (Thornhill).

Regarding claims 1-3, Figures 1-2 of Thornhill show an elongate member with a mounting clamp 23 and contact means 45.

Regarding claim 11, Figure 2 shows two second ends 45,55.

Regarding claim 15, Figure 1 also shows a putter 13.

8. Claims 1-3, 5, 10 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 4,170,356 (Banks).

Regarding claims 1-3, 5, 10, 13 and 14, Figures 2-4 of Banks show an elongate member 18 with a mounting clamp 20 at one end and a contact means 21,22 at the other end.

Regarding claim 7, Figure 4 shows the recited scale 46'.

Regarding claim 15, any golf club can be used as a putter.

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9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Banks as applied above in view of U.S. Patent Number 7,090,588 (Bamber).

The Banks contact means has a rounded soft tip but it is not in the form of a ball. See column 2, lines 21-29. However, Bamber teaches that a resilient ball can be used with golf training devices to provide a golfer with a noticeable yet comfortable feel when it contacts the golfer. See Bamber at column 4, lines 37-45 and Figure 1. As such, it would have been obvious to one of ordinary skill in the art to provide a resilient ball at the distal end of the Banks elongate member in view of Bamber for the purpose recognized in the golfing art as discussed above.

10. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banks as applied above.

Regarding claim 6, the Banks mounting allows for multiple degrees of freedom but does not show a ball joint. However, because these two elements were art-recognized equivalents at the time of the invention in those joint applications where it is immaterial how the elongate member is able to move within the mounting, one of ordinary skill in the art would have found it obvious to substitute a ball joint for the mounting joint of Banks.

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Regarding claim 12, it would have been an obvious matter of design choice to make the Banks contact means separable from the elongate member, since it has generally been recognized that to make elements separable involves only routine skill in the art, especially to make replacing elements more convenient.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banks as applied above in view of U.S. Patent Number 5,904,624 (Martinez).

Regarding claim 8, Banks shows the elongate member to be longitudinally adjustable but not telescopically. Martinez discloses a golf training device with longitudinally adjustable arms that are telescopic. It would have been obvious to one of ordinary skill in the art to make the Banks elongate member telescopically adjustable in view of Martinez who teaches the equivalence of adjustably sliding a golf training device to accommodate the distance between the device and different golfers.

Regarding claim 9, the concept of using indicia to make specific positions of an adjustable element is old and well-known in the art. See Banks above with respect to angular markings 46'.

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Conclusion

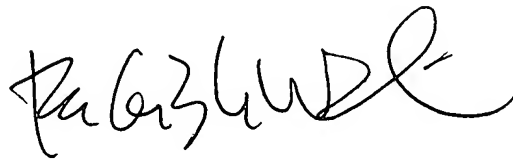
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on (571) 272-4463.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu
Primary Examiner
Technology Center 3700

RWC:dei:feif
22 December 2006